

Appl. No. 10/672,729  
Amnt. dated 11/29/06  
Reply to Office Action of Sept 29, 2006

RECEIVED  
CENTRAL FAX CENTER  
NOV 29 2006

### **REMARKS/ARGUMENTS**

Claims 1-14 remain in this application. Claim 1 is currently amended to clarify the scope of the invention, and claims 9 and 10 were previously amended.

Claims 10-14 are allowed.

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102 (b) as anticipated by Perry 5,817,143. Claims 1-14 are rejected under 35 U.S.C. 103(a) as unpatentable over Polito 5,427,121 in view of Maxwell 4,135,020.

#### **35 U.S.C. 102(b) rejections:**

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102 (b) as anticipated by Perry 5,817,143.

Claim 1 has been amended to specify that the stencil is "configured for contact with a portion of a fingernail or toenail." While the term "adapted to" has been held not to be a positive limitation, the term "configured to" is a positive limitation. The Perry invention is not configured for contact with a portion of a nail, as it is "conformed to be removably attached to a user's clothing" either by sewing via thread holes 14 or via a snap in place universal retainer as shown in Figure 3.

Furthermore, Claim 1 has been amended to specify that the cut-out portion is "configured to form a three dimensional design on the nail." Perry is not configured to form a three dimensional design on a nail. On the contrary, the Perry invention is beveled so that the bottom opening of the design is smaller than the top opening. This is because the Perry invention is designed to form tan spots on skin, and the bevel prevents shadows. This bevel would pull a design right back off of a nail, however.

Hence, Claim 1 is not anticipated by Perry. Claims 2-4 and 7-9 depend from claim 1.

35 U.S.C. 103(a) rejections:

Claims 1-9 are rejected under 35 U.S.C. 103(a) as unpatentable over Polito 5,427,121 in view of Maxwell 4,135,020.

The Examiner has noted that individual differences between the references and the present invention are not relevant when the rejections are based upon a combination of the references. This is true. Therefore, applicants will merely point out the following:

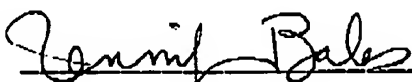
(1) There is no motivation provided to combine the two references. A manicurist would not look to methods of applying wall art to devise methods of applying nail art, particularly when the method described leaves thick designs of modeling paste that must cure for twenty-four hours.

(2) Even if the two methods were combined, it would still not result in the method of the present invention, as neither reference includes important features of the present invention, including a flexible stencil with walls of at least about 1 mm for forming a three dimensional design on the nail. Neither describes pouring the material for the design into the mold. Neither describes the use of poured acrylic to form the design.

As all of the claims now in the application appear to be in condition for allowance, applicant respectfully requests that the application be allowed and passed to issue as soon as possible.

Respectfully submitted,

MACHELEDT BALES & HEIDMILLER LLP

By 

Jennifer L. Bales

Registration No. 38,070

Telephone (303) 664-4734

Facsimile (303) 664-4735